

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Mary Rose Rice

Serial No.: 10/748,953

Filed: December 30, 2003

For: METHOD AND SYSTEM FOR  
ARRANGING A PAINT COLOR  
DISPLAY

Patent Examiner: Caschera, Antonio A.

Group Art Unit: 2628

January 24, 2007

Costa Mesa, California 92626

**PETITION FROM REQUIREMENT FOR RESTRICTION**  
**(37 CFR §1.144)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

Dear Sir:

Applicant petitions the Commissioner of Patents to correct the actions of the Examiner in the Office Action of December 27, 2006 making Final the requirement that claims 1-8 and 10-15, the only claims remaining in the application, are directed to a non-elected invention and withdrawing them from consideration.

The Office Action of December 27, 2006 was in response to applicant's request for reconsideration under 37 CFR §1.143, filed November 17, 2006.

### **STATEMENT OF FACTS**

This application was filed on December 30, 2003.

The Office Action of December 27, 2006 asserts that claims 1-8 and 10-15 are newly submitted.

Claims 1-8 and 10-15 are not newly submitted. These claims were originally elected as a result of the restriction requirement of March 2, 2005 requiring restriction between five different sets of claims.

In March of 2005, claims 1-15 were characterized by the Office Action as drawn to a method and system for displaying paint colors on sample cards.

The Examiner characterized claims 1-15 as being drawn to a method and system for displaying selected paint colors on sample cards without indicating that the claims were considered to be limited to computer graphics, to the exclusion of all other forms of graphics.

### **POINTS TO BE REVIEWED**

Whether reading claims 1-15 as drawn only to a computer graphics display in the face of the description of the claimed elements in the specification as physical elements, caused the claims to be improperly classified and an improper restriction requirement issued.

### **ARGUMENT**

Original independent method claim 1 recites a method for displaying color samples comprising selecting a plurality of paint colors, placing the selected paint colors on a plurality of sample cards and arranging the sample cards on a display unit. Original independent apparatus claim 8 recites a color display unit having a card display with a plurality of columns and rows, a first plurality of paint sample cards arranged along the first column of the card display, and a

second plurality of paint sample cards arranged within the first column and adjacent to a first plurality of sample cards.

None of the original claims 1-15 recite a data processing system, or computer, or any method to be performed by a computer or software. When the claims are read in light of the specification, as required, it is clear that a computer process or computer system is not contemplated and is not being claimed.

The specification, in the description of related art [Para. 0002] states “When selecting paints, it is often useful to display the paint colors available on color cards. Each card typically provides a color sample for a single paint color.” Furthermore, these cards are “. . . organized and displayed in such a way that the customer is able to find the desired color(s) with relative ease. Additionally, it would be helpful if the card arrangement could also ‘suggest’ other colors to the customer that would go well with a selected color.”

In the summary of the invention [Para. 0003], the specification states that “Paint color sample cards are arranged on a two-dimensional display surface such that colors have a similar hue angle, or colors that lie within a hue range, are characterized or grouped together (e.g., along a column) as a family of colors.” And, in paragraph 0004, the summary of the invention points out the physical nature of these cards when it states “Combination style cards may be provided within each color family. The combination style cards may include one or more color schemes having one or more colors found in the color family in which the combination style card is placed. . . In one embodiment, the combination style card is a tri-fold card including three different color schemes.”

The figures of the application clearly show the physical nature of the display (Figure 4) and the color cards (Figures 5-11).

In order not to mislead a careless reader into believing that the specification is talking about a computer system or program, the specification specifically points out in paragraph 0014 “In the following description, certain terminology is used to describe certain features of one or more embodiments of the invention. For instance, a paint color ‘display’ includes any cabinet, counter, advertising panel, cardholders, etc. and combination thereof that may be used to exhibit paint color sample cards for customers or shoppers.” The “display” recited by the claims is a cardholder for holding physical paint color sample cards for customers or shoppers, to remove from the cardholder and take with them.

As the specification points out in paragraph 0015, “One aspect of the present invention provides a method for systematically arranging paint color samples for convenient browsing, identification, and/or selection of desired colors by shoppers.”

To drive home the physical nature of the cards themselves, the specification again describes in paragraph 0017 a certain kind of color card, “In one implementation of the invention, the combination style card is a tri-fold card including three different color schemes.”

The specification refers in paragraph 0031 to the paint color display shown in Figure 4 which is clearly a two-dimensional physical cardholder containing rows and columns of physical paint sample cards.

In paragraph 0035, the physical characteristics of the tri-fold card are described. “Another feature of the invention provides for a plurality of combination style cards to be displayed along each column 402-414. Combination style cards are used to provide color scheme ideas to shoppers for some of the colors in the color display. In one implementation of the invention a combination style card is a tri-fold card including three different color schemes.”

The specification, [Para. 0036] goes on to describe that these cards are “laid out at particular locations (e.g., the beginning of one or more rows) along one or more columns of the color display.” This display, as defined earlier, is a cardholder.

The specification describes a variety of paint sample cards that can be used with the color display illustrated and described. Paragraph 0039 describes paint sample cards shown in Figure 5. The physical nature of the paint sample card of Figure 5 is clearly brought home by Figure 6, which is the back side of the paint sample card of Figure 5, as described in paragraph 0043 of the specification.

The specification then goes on to describe the various physical sample cards illustrated in Figures 7-11. In paragraph 0046 the sample cards shown in Figures 8-11 are described as “. . . tri-fold combination style cards include three color schemes and a corresponding sample room for each color scheme.”

The physical nature of the sample cards and the card display that holds these cards as recited in the claims and the specification seems readily apparent. Defining the word “display” in the specification to mean cardholder should convey to the reasonable reader that “display” as used in the claims does not mean a computer screen.

In the first Office Action of March 28, 2005 after election, the elected claims were rejected as anticipated by a Microsoft PhotoDraw 2000 software program.

In response, on November 1, 2005, applicant strenuously objected that the prior art reference fails to teach “. . . the invention of arranging a plurality of physical paint sample cards in a two-dimensional display as claimed.”

In the second and final Office Action of March 17, 2006, it was asserted that applicant’s arguments had been fully considered but were not persuasive. The Office Action specifically

pointed out “Firstly, the specific element of the paint sample cards being ‘physical’ is not seen within the claims. It is noted that the features upon which applicant relies (i.e., ‘physical paint sample cards’) are not recited in the rejected claim(s).”

The Office Action went on to state that accordingly, the PhotoDraw program can be interpreted as having paint sample cards.

Applicants took this as a clear invitation to include the word “physical” in the claims.

Along with a request for continued examination, on August 11, 2006, applicant specifically amended the claims to recite “A method for displaying paint color samples in a two-dimensional physical display unit, comprising. . . placing the selected plurality of paint colors on a first plurality of physical paint color sample cards with one color on each physical sample card.”

Applicant added the word “physical” into the claims. Not because he deemed it was necessary to clearly define the invention as comprising a physical card display with physical cards being held by the display, but because of the invitation in the Final Office Action of March 17, 2006 to make the claim more definite. Applicant still maintains, however, that the claims clearly recited physical structure, and not a computer system or computer software, even without the addition of the word “physical.”

On September 25, 2006, applicant received a second restriction requirement which withdrew all the amended claims 1-8 and 10-15 in the application from consideration, as being drawn to a non-elected invention, because, as stated in the Office Action “Since the amendment now defines the sample cards as ‘physical paint color sample cards’ (which was not the case in view of the originally filed claims).”

The result of withdrawing claims 1-8 and 10-15 leaves the application with no claims left for examination.

Defining the claimed invention of claims 1-15 as limited to a computer graphic system when the specification clearly describes a physical system for holding physical sample cards, is clear error.

**ACTION REQUESTED**

Applicant respectfully requests that the final restriction requirement be withdrawn and amended claims 1-8 and 10-15 be examined.

Very truly yours,

**SNELL & WILMER L.L.P.**



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